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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,347	02/12/2004	Lena Sojian	SLA1473	5085
7590 Gerald W. Maliszewski P.O. Box 270829 San Diego, CA 92198-2829				
EXAMINER DULANEY, BENJAMIN O				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/777,347

Applicant(s)

SOJIAN ET AL.

Examiner

BENJAMIN O. DULANEY

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 1) Claims 1-11 and 17-26 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 6,919,967 by Pentecost et al.
- 2) Regarding claim 1, Pentecost teaches in a multifunctional peripheral (MFP) (column 6, line 5; figure 1, item 18), a text overlaying method comprising: accepting a document (column 8, lines 32-36); accepting a text overlay message (column 8, lines 53-54); merging the overlay message with the document; and, creating a merged document (column 8, lines 55-64).
- 3) Regarding claim 2, Pentecost teaches the method of claim 1 further comprising: creating a paper media merged document (column 8, line 62).
- 4) Regarding claim 3, Pentecost teaches the method of claim 1 wherein accepting a document includes accepting a document selected from the group including paper media and electronically formatted documents (column 7, lines 40-42; pages from an application are electronic).

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- 5) Regarding claim 4, Pentecost teaches the method of claim 3 wherein accepting an electronically formatted document includes accepting a document selected from the group including text and image documents (column 5, lines 9-16).
- 6) Regarding claim 5, Pentecost teaches the method of claim 1 further comprising: electronically transmitting the merged document (column 8, lines 59-62; transmitted from DMU to print engine).
- 7) Regarding claim 6, Pentecost teaches the method of claim 2 wherein accepting a document includes: accepting a paper media document; converting the document to rasterized data; and, generating a first image (column 8, lines 42-43); wherein accepting an overlay message includes: accepting an electronically formatted overlay message; converting the overlay message to a Page Description Language (PDL) file; processing the PDL file as a print job; and, generating a second image as rasterized data (column 8, lines 53-54).
- 8) Regarding claim 7, Pentecost teaches the method of claim 6 wherein merging the overlay message with the document includes: adding the first image to the second image; and, generating a third image (column 8, lines 54-60).
- 9) Regarding claim 8, Pentecost teaches the method of claim 7 wherein printing the merged document includes sending the third image to an MFP print engine (column 8, line 61).
- 10) Regarding claim 9, Pentecost teaches the method of claim 6 wherein converting the overlay message to a PDL file includes converting the overlay message to a PDL

file selected from the group including Printer Control Language (PCL) and PostScript (PS) (column 6, lines 8 and 9).

11) Regarding claim 10, Pentecost teaches the method of claim 1 wherein merging the overlay message with the document includes accepting position commands for positioning the overlay message with respect to the document (column 11, lines 18-25).

12) Regarding claim 11, Pentecost teaches the method of claim 10 wherein merging the overlay message with the document includes accepting message characteristics selection commands chosen from the group including message size, message shape, font, color, and print options (column 9, lines 18-30).

13) Regarding claim 17, Pentecost teaches in a multifunctional peripheral (MFP) (column 6, line 5; figure 1, item 18), a text overlaying system comprising: a first subsystem having an interface to accept a document and an interface to supply document rasterized data (column 8, lines 32-36; figure 1, item 44); a second subsystem having an interface to accept a text overlay message and an interface to supply overlay rasterized data (column 8, lines 53-54; figure 1, item 44); and, a merge unit having an interface to accept the document rasterized data, an interface to accept overlay rasterized data, the merge unit merging the overlay message with the document and supplying a merged document at an interface (figure 1, item 50).

14) Regarding claim 18, Pentecost teaches the system of claim 17 further comprising: a print engine having an interface to accept the merged document and an interface to supply a paper media merged document (figure 1; item 52).

15) Regarding claim 19, Pentecost teaches the system of claim 17 wherein the first subsystem accepts a document selected from the group including paper media and electronically formatted documents (column 7, lines 40-42; pages from an application are electronic).

16) Regarding claim 20, Pentecost teaches the system of claim 19 wherein the first subsystem accepts an electronically formatted document selected from the group including text and image documents (column 5, lines 9-16).

17) Regarding claim 21, Pentecost teaches the system of claim 17 further comprising: a transceiver having an interface to accept the merged document and a network-connected interface to electronically transmit the merged document (figure 1).

18) Regarding claim 22, Pentecost teaches the system of claim 18 wherein the first subsystem is a copier pipeline accepting a paper media document and generating a first image of rasterized data (column 8, lines 42-43); and, wherein the second subsystem is a print pipeline accepting an electronically formatted overlay message, the print pipeline converting the overlay message to a Page Description Language (PDL) file, and processing the PDL file as a print job, to generate a second image of rasterized data (column 8, lines 53-54).

19) Regarding claim 23, Pentecost teaches the system of claim 22 wherein the merge unit adds the first image to the second image, and generates a third image (column 8, lines 54-60).

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20) Regarding claim 24, Pentecost teaches the system of claim 22 wherein the print pipeline converts the overlay message to a PDL file selected from the group including Printer Control Language (PCL) and PostScript (PS) (column 6, lines 8-9).

21) Regarding claim 25, Pentecost teaches the system of claim 17 wherein the merge unit has a user interface (UI) to accept position commands, and positions the overlay message position with respect to the document position, in response to the position commands (column 11, lines 18-25).

22) Regarding claim 26, Pentecost teaches the system of claim 25 wherein the merge unit UI accepts message characteristics selection commands chosen from the group including message size, message shape, font, color, and print options, and modifies the overlay message in response to the selected message characteristics (column 9, lines 18-30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23) Claims 12, 15, 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,919,967 by Pentecost et al., and further in view of U.S. patent 5,959,743 by Tanaka.

24) Regarding claims 12 and 27, Pentecost does not specifically teach the method of claim 11 wherein accepting message characteristics selection commands includes: supplying user interface (UI) message characterization prompts at an MFP front panel; and, accepting user commands from the UI.

Tanaka teaches the method of claim 11 wherein accepting message characteristics selection commands includes: supplying user interface (UI) message characterization prompts at an MFP front panel; and, accepting user commands from the UI (figure 1, item 302; column 4, lines 15-19).

Pentecost and Tanaka are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Tanaka to add a UI to an MFP. The motivation for doing so would have been for an "operator" to "set parameters" (Column 4, lines 16-17). Therefore it would have been obvious to combine Pentecost with Tanaka to obtain the invention as specified by claims 12 and 27.

25) Regarding claims 15 and 30, Pentecost teaches the method of claim 1 wherein accepting an overlay message includes accepting an overlay message from an interface.

Pentecost does not specifically teach an interface selected from the group including a scanner, stylus, smart card, virtual keyboard, and wireless personal digital assistant (PDA) interface.

Tanaka teaches an interface selected from the group including a scanner, stylus, smart card, virtual keyboard, and wireless personal digital assistant (PDA) interface (column 3, lines 20-27; figure 1).

Pentecost and Tanaka are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Tanaka to add a scanner to an MFP. The motivation for doing so would have been to input data. Therefore it would have been obvious to combine Pentecost with Tanaka to obtain the invention as specified by claims 15 and 30.

26) Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,919,967 by Pentecost et al., and further in view of U.S. patent 7,126,704 by Miura et al, and further in view of U.S. patent 5,809,167 by Al-Hussein.

Pentecost does not specifically teach the method of claim 10 wherein accepting position commands for positioning the overlay message with respect to the document includes: on an MFP display, presenting an image of the document; using a UI associated with the display, supplying prompts for superimposing the overlay message on the document; receiving user commands on the UI; positioning the overlay message in response to the commands.

Miura teaches the method of claim 10 wherein accepting position commands for positioning the overlay message with respect to the document includes: on a display,

presenting an image of the document (column 11, lines 52-60); using a UI associated with the display, supplying prompts for superimposing the overlay message on the document; receiving user commands on the UI; positioning the overlay message in response to the commands (column 12, lines 11-45).

Pentecost and Miura are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Miura to add altering merge data on a display. The motivation for doing so would have been to be able to preview user actions.

Al-Hussein teaches an MFP display (figure 3; column 5, lines 53-67).

Pentecost and Al-Hussein are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Al-Hussein to add an all-in-one PC/printing device. The motivation for doing so would have been "providing the operator with a powerful personal imaging computer system together with a general purpose computer system" (column 5, lines 64-66).

Therefore it would have been obvious to combine Pentecost with Miura and Al-Hussein to obtain the invention as specified by claim 13.

27) Claims 14, 16, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,919,967 by Pentecost et al., and further in view of U.S. patent 6,538,623 by Parnian et al.

28) Regarding claims 14 and 29, Pentecost teaches the method of claim 1 wherein accepting an overlay message includes: from an MFP controller; converting the ASCII code to a PDL file; and, generating a rasterized overlay message (column 8, lines 53-54).

Pentecost does not specifically teach receiving an ASCII code timestamp, including a date and time.

Parnian teaches receiving an ASCII code timestamp, including a date and time (column 36, lines 15-62).

Pentecost and Parnian are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Parnian to add timestamps. The motivation for doing so would have been to know when a modification is made (column 8, line 62). Therefore it would have been obvious to combine Pentecost with Parnian to obtain the invention as specified by claims 14 and 29.

29) Regarding claims 16 and 31, Pentecost does not specifically teach the method of claim 1 further comprising: generating dynamic data selected from the group including document page count, timestamp, MFP name, and MFP identification (ID); and, wherein

merging the overlay message with the document includes additionally merging the dynamic data with the document.

Parnian teaches the method of claim 1 further comprising: generating dynamic data selected from the group including document page count, timestamp, MFP name, and MFP identification (ID); and, wherein merging the overlay message with the document includes additionally merging the dynamic data with the document (column 36, lines 15-62).

Pentecost and Parnian are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Parnian to add timestamps. The motivation for doing so would have been to know when a modification is made (column 8, line 62). Therefore it would have been obvious to combine Pentecost with Parnian to obtain the invention as specified by claims 16 and 31.

30) Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,919,967 by Pentecost et al., and further in view of U.S. patent 5,959,743 by Tanaka, and further in view of U.S. patent 7,126,704 by Miura et al, and further in view of U.S. patent 5,809,167 by Al-Hussein.

Pentecost (as modified by Tanaka) does not specifically teach the system of claim 27 wherein the MFP front panel UI displays an image of the document, supplies prompts for superimposing the overlay message on the document, and accepts user

commands; and, wherein the merge unit positions the overlay message in response to the commands accepted at the MFP front panel UI.

Miura teaches the system of claim 27 wherein the UI displays an image of the document, supplies prompts for superimposing the overlay message on the document (column 11, lines 52-60), and accepts user commands; and, wherein the merge unit positions the overlay message in response to the commands accepted at the UI (column 12, lines 11-45).

Pentecost (as modified by Tanaka) and Miura are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Miura to add altering merge data on a display. The motivation for doing so would have been to be able to preview user actions.

Al-Hussein teaches an MFP front panel UI (figure 3; column 5, lines 53-67).

Pentecost (as modified by Tanaka) and Al-Hussein are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Al-Hussein to add an all-in-one PC/printing device. The motivation for doing so would have been "providing the operator with a powerful personal imaging computer system together with a general purpose computer system" (column 5, lines 64-66).

Therefore it would have been obvious to combine Pentecost with Tanaka, Miura and Al-Hussein to obtain the invention as specified by claim 28.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN O. DULANEY whose telephone number is (571)272-2874. The examiner can normally be reached on Monday - Friday (10am - 6pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin O Dulaney/

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Examiner, Art Unit 2625

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625